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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,127	05/31/2006	Kikue Hayashihara	HAYASHIHARA ET AL-1 PCT	2612
25889	7590	07/06/2009	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			ABU ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			07/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,127	Applicant(s) HAYASHIHARA ET AL.	
	Examiner SHUANGYI ABU ALI	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>note: this is a supplemental non-final rejection.</u> |

DETAILED ACTION

SUPPLEMENTAL NON-FINAL ACTION TO TAKE THE PLACE OF THE NON-FINAL

ACTION DATED 06/09/2009

The Examiner put the final rejection paragraph on the conclusion section by accident in the previous office action, and such paragraph has been deleted from the office action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/19/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claim the process of making the liquid clay is recited by two similar processes.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-5, 8-11, 13-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 47046212, in view of U. S. patent No. 4,792,357 to Bier.

Regarding claims 1, 3, 5 and 13-15, 212 disclose a paint composition comprising wood powder having a length of less than 0.3 mm, CMC such as 3% CMC solution, PVA, pigment and suitable amount of water et al. But they are silent about the composition comprising alginate as applicant set forth in the instant application. (page 2 and example 1-3).

However, it would have been obvious to one of ordinary skill in the art to use alginate in the 212' paint composition, motivated by the fact that Bier, also drawn to a paint composition, discloses that water soluble binder such as cellulose, PVA and

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alginates are used in the paint composition (col. 4, lines 21-40) and the binder amount is up to 20% and it is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of CMC and alginate) that is to be used for the same purpose (i.e. as a water soluble binder) to improve the binding property of the composition (col. 4, lines 17-18)

Regarding claims 4 and 17, Bier discloses that titanium oxide is used as pigment in the paint composition (example 7).

Regarding claim 8, '121 discloses that the paint composition is stored in a container (Page 3, lines 20-23).

Regarding claim 9, Although '212 is silent about the specific amount of the components used in the composition as applicants set forth in the instant application, it discloses that suitable amount of water is used in the composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicants to vary the water amount to change the components amount in the final composition according to the end use of the composition (page 2 of the translation).

Regarding claim 10, '212 disclose that the water amount can be varied. When the water amount is in the range of 391-187.6 part, the amount of the wood powder is in the range of 19% to 31%.

Regarding claim 11, '212 disclose that the water amount can be varied. When the water amount is in the range of 65 part, the amount of the pigment (titanium oxide) is 5%.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of JP 47046212, in view of U. S. Patent No. 4, 792,357 to Bier, further in view of FR 2567795.

Regarding claim 6, combined teaching of '212 and Bier disclose a composition as applicant set forth in claim 1, but they are silent about the origin of the sawdust as applicant sets forth in claim 5.

However, it would have been obvious to one of ordinary skill in the art to use the sawdust as applicant sets forth in claim 6, motivated by the fact that '795, also drawn to a coating composition, discloses that oak sawdust, as is a known wood powder, is used in the coating composition to obtain greater strength and workability (abstract).

Response to Arguments

Applicant's arguments filed 03/19/2009 have been fully considered but they are not persuasive.

Applicant argues that JP'212 and '347 are combined based on impermissible hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). For the instant case, the JP'212 discloses a liquid clay-liked composition

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comprises of CMC, PVC, wood powder and pigment. Bier, also drawn to a paint composition, discloses that water soluble binder such as cellulose, PVA and alginates are used in the paint composition (col. 4, lines 21-40) and the binder amount is up to 20% . It is prima facie obvious to combine two or more materials disclosed by the prior art to form a third material (mixture of CMC and alginate) that is to be used for the same purpose (i.e. as a water soluble binder).

Applicant argues that sodium alginate is better known for the use as a food additive, not a binder for use in clay (clay like composition?). The Examiner respectfully submits that Bier disclose that the sodium alginate is used for binder.

Applicant argues that Bier disclose that sodium alginate is used in an amount of at least 3%. The Examiner respectfully submits that Bier disclose that the binder amount is used as up to 20%, which includes 0-3%.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. A./

Examiner, Art Unit 1793

/J.A. LORENZO/

Supervisory Patent Examiner, Art Unit 1793